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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,888	10/27/1999	CHRISTINE DUPUIS	05725.0473	3192

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/380,888

Applicant(s)

DUPUIS, CHRISTINE

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 18-53 are pending.

#### ***Request for Continued Examination***

The request filed on 7/3/02 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/380888 is acceptable and an RCE has been established. An action on the RCE follows.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 18-53 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the 112 rejection in the Previous Office Action over new matter, the Examiner notes that formula  $\text{--CO--A--CO--O(CH}_2\text{CH}_2\text{O)}_n\text{--}$ , added in the Preliminary Amendment, finds support in the Priority Document on page 15, line 21.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 18-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,031,043. Although the conflicting claims are not identical, they are not patentably distinct from each other. While US 6,031,043 fails to teach the viscosity properties of the instant invention, It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach such properties in the invention of US 6,031,043, since the viscosity is a property gelling polymer, and US 6,031,043 and the instant application teach the exact same gelling polymers.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22 and 40-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 18-22, 40-53 are rejected because the compound in these claims is not defined with any chemical or physical characteristic, but only by functional properties. A claim to a material defined solely in terms of what it can do, or a property thereof, does not particularly point out the claimed invention. Thus, the scope is indefinite. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims <sup>18</sup>~~18~~-36, 39, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. (4,300,580).

O'Neill et al. teach hair grooming methods using compositions comprising linear polyesters. Linear polyesters disclosed are derived from at least one dicarboxylic acid, at least one diol, and a difunctional monomer containing a -SO<sub>3</sub>M group attached to an aromatic nucleus. The difunctional monomer containing the -SO<sub>3</sub>M groups is disclosed as comprising at least 8 mole percent of the polyester, and the diol is disclosed as comprising at least 8 mole percent, and preferable from 12-45 mole percent, of the polyester. Exemplified is a polymer made by mixing dimethyl isophthalate (1,3 phenylene group), dimethyl terephthalate (1,4 phenylene group), dimethyl 5-sodiumsulfoisophthalate (sulfo-1,3-phenylene group), and diethylene glycol, wherein the polymers are disclosed as comprising 5% of the composition as a whole. The composition is applied as a spray to the hair. Dyes, pigments, stabilizers, and plasticizers are disclosed as additives. The reference lacks preferred percent weights of the monomer units. See Col. 1, line 41-Col. 5, line 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the mole percents of the monomers of O'Neill et al. as those of the instant invention, since a) O'Neill et al. generally teaches the mole percents of the monomers, and b) it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 18, 37-38, 40-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. in view of Lee et al. (EP 0551748).

O'Neill et al. is applied as discussed above. The reference lacks a fatty phase and a device.

Lee et al. teach hair treatment compositions comprising a water-insoluble, dispersible polymeric resin in water. Diglycol/cyclohexanedimethanol/isophthalates/sulphoisophthalates polyester is disclosed as a resin. Hairsprays in aerosol and nonaerosols are disclosed. Dimethyl ether, propane, butane, and isobutene are disclosed as propellants gases for aerosols. The propellants are disclosed as comprising 3-50% of the composition. C10-C20 fatty alcohol esters are disclosed as additives that counteract the dullness effect of the polymeric resins. See pg. 3, lines 12-pg. 4, line 14.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the C10-C20 fatty alcohols of Lee et al. in the composition of O'Neill et al. because a) O'Neill and Lee are both directed to hair care compositions comprising sulfopolyesters in the form of sprays; b) Lee teaches that adding fatty alcohols to compositions comprising sulfopolyesters counteracts the dullness imparted to the hair by the polyesters.

### ***Unexpected Results***

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing"

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*In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, there are no unexpected results.

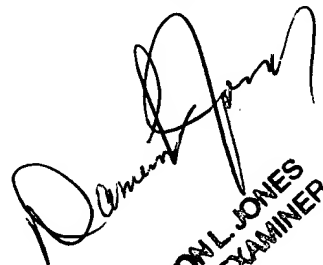
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell S. Travers can be reached on (703)308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
August 6, 2002

  
**DAMERON L. JONES**  
**PRIMARY EXAMINER**